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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,988	03/26/2004	Fernando Oliveira	EMC-02-119CIP1	9626
24227	7590	11/03/2006	EXAMINER	
EMC CORPORATION OFFICE OF THE GENERAL COUNSEL 176 SOUTH STREET HOPKINTON, MA 01748			PEIKARI, BEHZAD	
			ART UNIT	PAPER NUMBER
			2189	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,988

Applicant(s)

OLIVEIRA ET AL.

Examiner

B. James Peikari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-26 is/are allowed.
- 6) ☒ Claim(s) 27 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/23/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the application filed on August 23, 2006. Claims 1-27 and 29 have been submitted for examination.

Specification

1. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The status of the co-pending U.S. applications should be updated, as necessary, on page 1 of the specification (e.g., “, now abandoned” or “, now U.S. Patent No. ...”).

Claims

3. The numbering of the claims is not in accordance with 37 CFR 1.75(f), which requires that the claims be numbered consecutively. The claims include numbers 1-27 and 29, with no claim 28.

Nevertheless, the original numbering will be preserved during the prosecution of this application and will be renumbered by the Office if the application is allowed (note 37 CFR 1.126).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 27 and 29 are not limited to tangible embodiments. Claims 27 and 29 includes a program product that was not a proper computer readable medium. In view of Applicant's disclosure, specification page 9, 3rd paragraph, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., read only-memory or any other machine readable storage medium) and intangible embodiments (e.g., transmission medium). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

(A) Claims 27 and 29 have been amended to include the word "tangible", however, page 10 of the remarks submitted with the amendment of August 23, 2006, explicitly states, "Applicants do not necessarily agree that the cited transmission mediums are not tangible".

Since the word "tangible", as used by applicant in the claims, has been further defined in the remarks of August 23, 2006 as possibly including "the cited transmission mediums", the claims are non-statutory.

(B) In claim 29, the program product operates "in a tangible environment", but is not necessarily "tangibly embodied" anywhere (i.e., stored on a tangible storage medium). Therefore, claim 29 is non-statutory.

Claim Rejections - 35 USC § 102

6. The previous rejections under 35 U.S.C. 102(e) are withdrawn due to the remarks submitted with the amendment of August 23, 2006.

Response to Arguments

7. Applicant's arguments filed on August 23, 2006 have been fully considered but they are not fully persuasive.

(A) The objection to the specification has been overcome by the amendment.

(B) With regard to the rejection under 35 USC § 101, the rejections are maintained for the reasons provided above.

(C) With regard to the rejection under 35 USC § 102, the rejections are withdrawn because applicant has suggested throughout the remarks (note especially page 12) that the claims are limited to the specific implementation of an "intelligent multi-protocol switch (IMPS)", and all the specific features and attributes thereof, which are outlined in the remarks and in applicant's disclosure. In other words, since the IMPS was not a term of art at the time of the invention, the interpretation of this feature of the claim must be defined and limited by applicants disclosure and the statements made in the remarks of August 23, 2006.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Peikari whose telephone number is (571) 272-4185. The examiner is generally available between 7:00 am and 7:30 pm, EST, Monday through Wednesday, and between 5:30 am and 4:00 pm on Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reginald Bragdon, can be reached at (571) 272-4204. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'B. James Peikari', with a long horizontal stroke extending to the right.

B. James Peikari
Primary Examiner
Art Unit 2189
10/29/06